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SEP 16 2002

OFFICE OF PETITIONS

In re Application of
Horne
Application No. 10/057,983
Filed: 29 January, 2002
Attorney Docket No. 82001-0297

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: DECISION ON PETITION
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This is a decision on the petition filed on 21 June, 2002, under 37 C.F.R. §1.47(a), but considered under 37 C.F.R. §1.47(b)¹ because the case is a matter in which no inventor signs the oath or declaration since the sole inventor cannot be found or refuses to sign.

The petition is **DISMISSED**.

Any petition (and fee) for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(b)" and may include an oath or declaration executed by the inventors.

Failure to respond will result in abandonment of the application.

BACKGROUND

The record indicates:

- this application was filed on 29 January, 2002, without, *inter alia*, an executed oath or declaration by the sole named inventor Martin Horne (Mr. Horne);
- accordingly, a Notice of Missing Parts was mailed on 21 February, 2002;
- in response to the Notice of Missing Parts, Petitioner filed on 21 June, 2002, *inter alia*, a request and fee for a two- (2-) month extension of time, the surcharge and the instant petition and fee;
- the petition fails to enclose/attach a copy of the transmittal letter(s) accompanying and evidencing the mailing of the entire application (specification including description, claims, abstract and the drawings) to Mr. Horne at his last known address.

¹ The regulations at 37 C.F.R. §1.47, in pertinent part:

§1.47 Correction of inventorship in a patent application, other than a reissue application.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in §17(i), and the last known address of all of the inventors. The Office shall, except in a continued prosecution application under §1.53(d), forward notice of the filing of the application to all of the inventors at the addresses stated in the application and publish notice of the filing of the application in the *Official Gazette*. An inventor may subsequently join in the application on filing an oath or declaration complying with §1.63.

Because the documentation otherwise supporting the petition was present, a call was placed to the office of Counsel requesting that the document(s) in question be forwarded via FAX to the Office of Petitions, however, as of this writing no response has been received.

ANALYSIS

While Petitioner has to established its proprietary interest and that the inventors cannot be found to sign the declaration (the proof of the pertinent events must be made by a statement of someone with first hand knowledge of the events) or cannot be reached, the Office requests a copy of the transmittal letter evidencing the mailing of the entire application (specification including description, claims, abstract and the drawings) to Mr. Horne at his last known address.

A copy of the application papers must be sent to the last known address of the non-signing inventor(s) with a request that he/she sign the declaration for the patent application. A forwarding address should be requested, if the papers are returned, and other attempts to locate the inventor, e.g. through e-mail or the telephone continue to fail, then applicant will have established that the inventor(s) cannot be reached.

The submission must contain documentation evidencing that the entire application and the oath or declaration were sent to the inventors at his/her last know address. Such evidence should included a copy of the transmittal letter (not previously included herein) and a copy of the shipping waybill and the shipper's indication of delivery, refusal, or other non-delivery conditions.

An oath or declaration for the patent application in compliance with 37 C.F.R. §1.63 and §1.64 must be presented. The declaration must set forth the inventor's residence, citizenship and post office address. (An oath or declaration in compliance with 37 C.F.R. §1.63 and §1.64 signed by the Rule §1.47 applicant is required.)

Moreover, Petitioner's Counsel must set forth in his/her statement their attestation that he/she believes all of the information submitted to be correct--including the required foregoing items and the statement of the last known addresses of the inventors.

Further correspondence with respect to this matter should be addressed as follows:

By mail:	Commissioner of Patents and Trademarks Box DAC Washington, D.C. 20231
By FAX:	(703) 308-6916 Attn: Office of Petitions
By hand:	Crystal Plaza Four, Suite CP4-3C23 2201 South Clark Place Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 305-9199.

A handwritten signature in black ink, appearing to read "John J. Gillon, Jr.", with a stylized flourish at the end.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy